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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,682	07/15/2003	Sarah Elizabeth Witt	450110-04642	7074

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EXAMINER

BRIER, JEFFERY A

ART UNIT PAPER NUMBER

2628

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/619,682

Applicant(s)

WITT ET AL.

Examiner

Jeffery A. Brier

Art Unit

2628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8, 16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/24/2006 has been entered.

### ***Response to Amendment***

2. The amendment filed on 5/24/2006 has been entered.

### ***Response to Arguments***

3. Applicant's arguments filed 5/24/2006 have been fully considered but they are not persuasive.

The arguments spanning pages 9 to 11 are not persuasive because the specification clearly sets forth an order to the video processing, steps 1510 to 1560, thus, a claim to video processing must follow the disclosed order of steps 1510 to 1560 otherwise the claim would have to stand on its own for support under 35 USC 112 first paragraph.

The arguments in the first full paragraph on page 11 are not persuasive because the body of the claim does not prepare an anti-aliased foreground image for display over an image background because the independent claims omit essential steps.

The argument in the last paragraph on page 11 and the first paragraph of page 12 has been considered. It would be acceptable to say that a foreground image with an alpha of 1 will superpose over the background image.

The argument regarding the Summary of the Invention is not persuasive. Applicant should make reference to MPEP 1302.01. In this application the Summary of the Invention does not correspond to the allowable claim limitations. The detailed description appears to be acceptable.

The argument at page 12 last paragraph concerning claim 2 is persuasive in view of the amendments made to claim 2.

The argument at page 13 first paragraph concerning claim 8 is persuasive in view of the amendments made to claim 8.

### ***Specification***

4. The disclosure is objected to because of the following informalities: the amendment filed on 10/11/2005 introduced paragraph numbers while the specification does not have paragraph numbers. Appropriate correction is required.

5. The abstract of the disclosure is objected to because it fails to express the claimed invention indicated as allowable. Correction is required. See MPEP § 608.01(b).

6. Applicant is required to modify the brief summary of the invention so that they are confined to and in harmony with the invention to which the allowed claims are directed. See MPEP § 1302.01.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 1-8, 16, and 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 17:

In view the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" published on the USPTO website on October 26, 2005,

[http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101\\_20051026.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf)

and published in the OG 22Nov2005

<http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm>) this claim in non-statutory because page 17 line 16-18 defines the program storage medium as a transmission medium which is a signal.

Page 17 line 16-18 states:

It will be appreciated from the above that the invention may be implemented as computer software, which may be supplied on a storage medium or via a transmission medium such as a network or the internet.

Therefore, the specification defines program storage medium as a signal. In ANNEX IV Computer-Related Nonstatutory Subject Matter of the Interim guidelines a signal is held to be nonstatutory subject matter and since applicants carrier wave is a signal then these claims are nonstatutory.

Art Unit: 2628

Applicant should note that amendments to the specification, such as deletion, may introduce new matter into the specification. Thus, an appropriate amendment to the claims is necessary to make the claims statutory.

Additionally the claim format of this claim does not follow the Interim Guidelines because the terms "program storage medium" and "video processing apparatus" does not manifest a computer readable medium and computer. See pages 50-55 of the Interim Guidelines.

Claims 1-8, 16, and 17:

This application is directed to a useful, concrete, and tangible result of displaying the processed video, however, these claims are not. These claims are directed to manipulating abstract processing without claiming a useful and tangible result. State Street Bank & Trust Co. v. Signature Financial Group Inc. (CA FC) 47 USPQ2d 1596, 1603 (7/23/1998). AT&T Corp. v. Excel Communications Inc. (CA FC) 50 USPQ2d 1447. On page 1603 first paragraph the CAFC wrote in State Street:

Under Benson , this may have been a sufficient indicium of nonstatutory subject matter. However, after Diehr and Alappat , the mere fact that a claimed invention involves inputting numbers, calculating numbers, outputting numbers, and storing numbers, in and of itself, would not render it nonstatutory subject matter, unless, of course, its operation does not produce a "useful, concrete and tangible result." Alappat , 33 F.3d at 1544, 31 USPQ2d at 1557. 7

On page 1603 paragraph labeled [4] the CAFC wrote:

[4] The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to 9 -- process, machine, manufacture, or composition of

matter--but rather on the essential characteristics of the subject matter, in particular, its practical utility. Section 101 specifies that statutory subject matter must also satisfy the other "conditions and requirements" of Title 35, including novelty, nonobviousness, and adequacy of disclosure and notice. See *In re Warmerdam*, 33 F.3d 1354, 1359, 31 USPQ2d 1754, 1757-58 (Fed. Cir. 1994).

These claims claim in the preamble “for display” but the results of the body of the claims do not display. See pages 19-22 of the Interim Guidelines.

### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-8, 16, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following side by side chart correlates claim 1 with the specification.

Claim	Disclosed steps
<p>Claim 1 (Currently Amended): A video processing method for preparing an anti-aliased foreground image for display over an image background, said method comprising:</p> <p>generating original foreground image signals by manipulation of a contiguous group of graphics primitives;</p> <p>applying anti-aliasing filtering to edges of each primitive of said group of</p>	<p>Step 1510, page14 lines 21-29, page 17 lines 1-15, figure 9A</p> <p>Step 1510, page 15 lines 16-32, page 17 lines 1-15, figure 9A</p>

primitives to generate primitive-processed image signals;	
preparing said image background for display;	Step 1520, page 17 lines 1-15
first processing said primitive-processed image signals to superpose said primitive-processed image over said image background; and	????
second processing said original foreground image signals to superpose said original foreground image over said primitive-processed image.	step 1530, page 15 line 33 to page 16 line 13, page 17 lines 1-15, figure 9B

After reviewing the specification a corresponding step or description cannot be found for the claimed step "first processing said primitive-processed image signals to superpose said primitive-processed image over said image background". Thus, this claim does not clearly claim applicants invention. Claims 16 and 17 have the same issue. Dependent claims 2-8 do not correct this issue.

### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.



11. Claims 1, 16, and 17 rejected under 35 U.S.C. 102(e) as being anticipated by Kitsutaka, US Patent No. 7,042,463. Kitsutaka describes at column 8 line 57 to column 9 line 14 with reference to figure 2 defocusing an original image and then superposing the original image onto the defocused image. Kitsutaka also teaches at column 14 line 67 anti-aliasing the original image as it is generated. Kitsutaka also teaches at column 16 line 56 an alternative method of defocusing by offsetting the original image. Thus, due to the breadth of claims 1, 16, and 17 Kitsutaka teaches these claims. A detailed analysis follows.

Claim 1:

Kitsutaka teaches a video processing method for preparing an anti-aliased foreground image for display over an image background, said method comprising:

generating original foreground image signals by manipulation of a contiguous group of graphics primitives (*The image generating section 130 generates an image by the method of polygons which are graphics primitives, column 6 lines 62-67, column 7 lines 16-24, and column 7 line 65-column 8 line 2. The drawing processor 910 also generates graphics primitives. Column 14 line 55 to column 15 line 2.*);

applying anti-aliasing filtering to edges of each primitive of said group of primitives to generate primitive-processed image signals (*The drawing processor 910 also generates graphics primitives and can anti-alias the generated primitives. Column 14 line 55 to column 15 line 2. Anti-alias at column 14 line 67.*);

preparing said image background for display (*This system is designed for games which to one of ordinary skill in the art have foreground objects over a background. Also at column 16 lines 62-65 discusses a foreground object merging with the background. Thus, Kitsutaka teaches preparing an image background for display.*);

first processing said primitive-processed image signals to superpose said primitive-processed image over said image background (*The image generating section 130 generates an image by the method of polygons which are graphics primitives and performs various processing the polygons. The drawing processor 910 also generates graphics primitives and can in addition to anti-alias perform various processing on the polygons. Column 14 line 64-67. Thus, Kitsutaka teaches first processing.*); and

second processing said original foreground image signals to superpose said original foreground image over said primitive-processed image (*At column 8 line 57 to column 9 line 14 with reference to figure 2 the defocused original image is superposed onto the defocused image.*).

Claim 16:

This apparatus claim claims the same functions found in claim 1 and this claim is rejected for the reasons given for claim 1. Additionally Kitsutaka teaches the claimed apparatus for performing the claimed functions and these apparatus were addressed in the rejection of claim 1.

Claim 17:

Art Unit: 2628

This program storage medium claim claims the same functions found in claim 1 and this claim is rejected for the reasons given for claim 1. Additionally Kitsutaka teaches the claimed program storage medium at column 6 lines 36-42.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kitsutaka, US Patent No. 6,927,777, describes at column 8 line 61 to column 9 line 18 with reference to figure 2 describes an original image and then superposing the original image onto the defocused image. This patent is a divisional of US Patent Application S.N. 09/913,281, US Patent No. 7,042,463.

Kitsutaka, US PGPub 2002/0158888, corresponds to US Patent Application S.N. 09/913,281, US Patent No. 7,042,463.

### ***Allowable Subject Matter***

13. Claims 2-8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, and 35 U.S.C. 101 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

14. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or suggest the following aspects of claim 2:

low-pass filtering said combined image to generate a low-pass filtered foreground image;

detecting peripheral edge regions of said group of graphics primitives; and

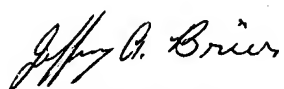
superposing said peripheral edge regions of said low-pass filtered image over said combined image. Kitsutaka '463 teaches at column 16 line 56 an alternative method of defocusing by offsetting the original image by shifting the original image, however, this low pass filtering is not performed on the combined image.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:00 to 3:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (571) 272-7664. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 2628

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "Jeffery A. Brier". The signature is written in a cursive style with a large, stylized "J" and "B".

Jeffery A Brier  
Primary Examiner  
Division 2628